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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/331375

Applicant(s)

Cohen et al.

Examiner

Regina DeBerry

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on 9/4/01

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

20) ☐ Other

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## DETAILED ACTION

### *Election/Restriction*

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1, 5-20, 24, 28 and 29, drawn to a pharmaceutical composition comprising isolated mammalian myogenic precursor cells and a morphogen, as well as a method of using the composition to promote proliferation or differentiation of the precursor cells into functional myocardium.
- II. Claims 2, 5-12, 21 and 25, drawn to drawn to a pharmaceutical composition comprising isolated mammalian myogenic precursor cells and an inducer of a morphogen, as well as a method of using the composition to promote proliferation or differentiation of the precursor cells into functional myocardium.
- III. Claims 3, 5-12, 22 and 26, drawn to a pharmaceutical composition comprising isolated mammalian myogenic precursor cells and an agonist of a morphogen receptor, as well as a method of using the composition to promote proliferation or differentiation of the precursor cells into functional myocardium.

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- IV. Claims 4-12, 23 and 27, drawn to a pharmaceutical composition comprising isolated mammalian myogenic precursor cells and a small molecule morphogenic activator, as well as a method of using the composition to promote proliferation r differentiation of the precursor cells into functional myocardium.
- V. Claim 30 (in part) , drawn to a pharmaceutical composition comprising a morphogen and a mitogen as well as a method of using the composition to promote proliferation r differentiation of the precursor cells into functional myocardium.
- VI. Claim 30 (in part) , drawn to a pharmaceutical composition comprising a morphogen inducer and a mitogen as well as a method of using the composition to promote proliferation r differentiation of the precursor cells into functional myocardium.
- VII. Claim 30 (in part) , drawn to a pharmaceutical composition comprising an agonist of a morphogen receptor and a mitogen.
- VIII. Claim 30 (in part) , drawn to a pharmaceutical composition comprising a small molecule morphogenic activator and a mitogen.

The inventions listed as Groups do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The PCT rules define a "special technical feature" as that feature which defines a contribution to the prior art. The special technical feature of the first claimed

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invention is a composition comprising the combination of myogenic precursor cells and a morphogen. Inventions II-IV recite different compositions, specifically, myogenic precursor cells in combination with structurally different agents. These different combinations define a different contribution over the prior art. Finally, the compositions of Inventions V-VIII do not require myogenic precursor cells, and thus also define a different contribution over the prior art.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina DeBerry, Ph.D., whose telephone number is (703) 305-6915. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D., can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

ECK  
September 27, 2001

*Elizabeth C. Korman*